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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,823	09/12/2003	John Mahdessian	P/4338-6	7854

7590

09/30/2004

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EXAMINER
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DOUYON, LORNA M

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/660,823

Applicant(s)

MAHDESSIAN, JOHN

Examiner

Lorna M. Douyon

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 22-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2 pages.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

*Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-18, 22-27, drawn to a comprehensive stain removal kit, classified in class 510, subclass 277.
  - II. Claims 19-21, drawn to a method for removing a stain from a stained fabric, classified in class 8, subclass 137.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product such as the product of You et al. (US Patent No. 5,872,090).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Brendan J. Kennedy on September 23, 2004 a provisional election was made without traverse to prosecute the invention of group I, claims 1-18

and 22-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-21 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### *Specification*

5. The amendment filed November 4, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The replacement of paragraph [0016] on page 4 with the added limitation of other types of absorbent material..., for example, absorbent cotton balls, pads, sponges... are nowhere supported in the original specification. Hence, the added limitation is considered as containing new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

### *Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-13, 15-18, 22-27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mahdessian (US Patent No. 6,013,614).

Mahdessian teaches a comprehensive stain removal kit containing use packets of various spotting agents and a stain guide directing use of the various spotting agents to effectively remove any type of known or unknown stain, the spotting agents include wet side spotting agents and a dry side spotting agent, with rinse solution to remove the wet side spotting agents and nonwoven, embossed, synthetic webs are impregnated with the various solutions and sealed within vapor-impervious packets (see abstract). Wet side spotting agents include alkaline wet side spotting agent which includes ammonia, and an acidic wet side spotting agent which includes acetic acid, oxalic acid or hydrofluoric acid (see col. 1, lines 65-67; col. 2, lines 31-39). Dry side spotting agent includes volatile dry solvent or oily type paint removers (see col. 2, lines 39-44). The nonwoven, embossed applicator has a 3 to 1 rayon/polypropylene blend (see col. 2, lines 50-53) and an additional layer of polyester (see col. 3, lines 1-4). Rinse packet contain webs impregnated with distilled water and all the packets are labeled to indicate use (see col. 3, lines 5-12). Figure 1 shows three different spotting agents with rinse packet and a dry packet (see Figure 1; col. 2, lines 30-59; claims 1-2). The recitation "an absorbent material for application to

a side of the fabric...” in claim 1, last three lines, are construed by the Examiner as **merely functional** and **does not** add a positive limitation. Hence, Mahdessian anticipates the claims. Since Mahdessian teaches each of the ingredient/component of the present stain removal kit, one of ordinary skill in the art would have expected that said kit would have **been capable** of being applied to a side of the fabric opposite that to which a stain treatment is to be applied to absorb at least one of the cleaning formula with stain material and the rinse solution.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mahdessian as applied to the above claims, and further in view of Simpson (WO 00/37602).

Mahdessian teaches the features as described above. Mahdessian, however, fails to disclose a spotting agent comprising enzymes.

Simpson teaches a similar stain remover composition comprising protease, amylase and an enzyme stabilizing system in a prepackaged wipe which permits the user to remove blood and organic spots (see abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized a spotting agent comprising an enzyme like protease or amylase in the comprehensive stain removal kit of Mahdessian because this would provide removal of blood stains and organic spots as taught by Simpson.

10. In the alternative, claims 1-13, 15-18, 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mahdessian in view of Young et al. (WO 98/05814), hereinafter “Young”.

Mahdessian teaches the features as described above. Mahdessian, however, fails to disclose an absorbent material for application to a side of the fabric opposite that to which a stain treatment is to be applied to absorb at least one of the cleaning formula with stain material and the rinse solution.

Young teaches a similar stain removing kit wherein the stained area of the fabric is placed over and in contact with an absorbent stain receiver, applying enough cleaning composition to the fabric, optionally allowing the composition to penetrate and removing the fabric from contact with the absorbent stain receiver (see page 3, lines 6-17). The stain receiver provides a particularly effective means of drawing stain-containing solvent through and away from a garment (see page 2, lines 6-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized the absorbent dry packet of Mahdessian by placing the stained area of the fabric over and in contact with an absorbent stain receiver because this will provide effective means of drawing stain-containing solvent through and away from a garment as taught by Young.

11. In the alternative, claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mahdessian in view of Young as applied to the above claims, and further in view of Simpson (WO 00/37602).

Mahdessian and Young teach the features as described above. The combination of references, however, fails to disclose a spotting agent comprising enzymes.

Simpson teaches a similar stain remover composition comprising protease, amylase and an enzyme stabilizing system in a prepackaged wipe which permits the user to remove blood and organic spots (see abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized a spotting agent comprising an enzyme like protease or amylase in the comprehensive stain removal kit of Mahdessian and Young because this would provide removal of blood stains and organic spots as taught by Simpson.

### *Double Patenting*

12. Claims 1-18, 22-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-4 of U.S. Patent No. 6,013,614. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to similar comprehensive stain removal kit comprising the same ingredients/components differing only in that the absorbent material of the present claims is used to perform a specific function. However, one of ordinary skill in the art would have expected that said kit would have **been capable** of being applied to a side of the fabric opposite that to which a stain treatment is to be applied to absorb at least one of the cleaning formula with stain material and the rinse solution.

*Conclusion*

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references are considered cumulative to or less material than those discussed above.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is (571) 272-1313. The examiner can normally be reached on Mondays-Fridays from 8:00AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Lorna M. Douyon*

Lorna M. Douyon  
Primary Examiner  
Art Unit 1751